

The opinion in support of the decision being entered today was not written for publication and is not precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAR 27 2003

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte SHAU-LIN F. CHEN,
RONALD M. HECK,
ZHICHENG HU
and MICHEL DEEBA

Appeal No. 2002-1684
Application No. 08/997,774

ON BRIEF

Before KRATZ, DELMENDO and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

REMAND TO THE EXAMINER

This is an appeal from the examiner's final rejection of Claims 1-7, 9-11, 15, and 17-20. Claims 8, 12-14, 16, and 21 have been canceled.

Our review of the application leads us to conclude that this appeal is not in condition for a decision at this time. Therefore, pursuant to our authority under 37 CFR § 1.193(b)(1) and § 1.196(a), last sentence, we remand this application to the examiner for consideration of our comments set forth below.

I. Background

Claim 1 is representative of the subject on appeal and is set forth below:

1. A catalytic converter system located downstream of an engine, the catalytic converter system being suitable for catalyzing the conversion of hydrocarbons, carbon monoxide, nitrogen oxides and other pollutants contained in an exhaust gas stream, the converter system comprising:

a low temperature conversion catalyst comprising a platinum group metal component dispersed on a support material, said low temperature conversion catalyst having a light-off temperature T_L of less than about 200°C, and being located relative to the exhaust gas stream such that said low temperature conversion catalyst is never exposed to a temperature in excess of about 550°C;

a hydrocarbon absorbent material located at a position selected from the group consisting of upstream of said low temperature conversion catalyst relative to the direction of flow of said exhaust gas stream and at said low temperature conversion catalyst relative to the direction of flow of said exhaust gas stream, and being capable of absorbing hydrocarbons present in said exhaust gas stream and of desorbing the absorbed hydrocarbons when the temperature of said low temperature conversion catalyst has exceeded said light-off temperature thereof; and

optionally, an upstream conversion catalyst, said upstream conversion catalyst, when present, being located upstream of said low temperature conversion catalyst relative to the direction of flow of said exhaust gas stream to be exposed to temperature in excess of 650°C.

The prior art references relied upon by the examiner as evidence of unpatentability are set forth below:

Giarrizzo	3,675,398	Jul. 11, 1972
Dunne	5,078,979	Jan. 07, 1992
Urata	5,218,817	Jun. 15, 1993
Abe et al. (Abe)	5,538,697	Jul. 23, 1996
Abe (EP '963) (European Patent Publication)	0602963 A1	Jun. 22, 1994
Frost (European Patent Publication)	0747851 A1	Dec. 11, 1996
Dettling (International Patent Publication)	W097/00119	Jan. 03, 1997

On page 2 of the answer, the examiner indicates that the 35 U.S.C. § 112 rejection has been withdrawn and the art rejections regarding the primary references of Abe, Frost, and Dettling have been withdrawn. The examiner does not indicate with specificity which of the art rejections have been withdrawn, other than by referring to the primary references involved in the rejections. The answer does include the following:

Claims 1, 2, 10, 11, 17, 18, and 19 stand rejected under 35 U.S.C. § 103 as being anticipated by Dettling.

Claims 1, 2, 6, 10, 11, 17, 18, and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over EP '963 in view of Abe (U.S. Patent 5,538,697).

Claims 3, 4, 8, 9, 12-15, 17, 18, and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dettling in view of Urata and Giarrizzo.

Claims 5, 17, 18, and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dettling in view of Dunne.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Dettling in view of EP '963.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Dettling in view of Dunne and further in view of EP '963.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable in view of Dettling in view of Frost.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Dettling in view of Urata and Giarrizzo and further in view of Frost.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Dettling in view of Dunne and further in view of Frost.

II. The Prosecution Below

1. Beginning on page 6 of the brief, appellants identify the rejections of record as set forth in the final rejection of Paper No. 16. Some of these rejections have been withdrawn in the examiner's answer, while some of these rejections have been maintained.

Beginning on page 14 of brief, appellants argue the rejection of claims 1, 2, 6, 10, 11, and 16-19 as being unpatentable under 35 U.S.C. § 103 over EP '963 in view of Abe (U.S. Patent 5,538,697).

2. On page 2 of the answer, the examiner indicates that some of the rejections have been withdrawn (albeit, the examiner's statement is not entirely specific as to which rejections have been withdrawn other than by referring to primary references, as mentioned, supra).

On page 5 of the answer, it is clear that the examiner has maintained the rejection of claims 1, 2, 6, 10, 11, 17, 18, and 19 under 35 U.S.C. § 103 as being unpatentable over EP '963 in view of Abe (U.S. Patent No. 5,538,697). However, the examiner

does not respond to appellants' arguments against this rejection. See pages 9-11 of the answer.

III. Discussion

In view of items 1 and 2 identified above, we determine that the examiner's answer is incomplete. That is, the answer does not include a response to the allegations or arguments in the brief, in particular, with respect to appellants' position regarding the rejection of claims 1, 2, 6, 10, 11, 17, 18, and 19 under 35 U.S.C. § 103 as being unpatentable over EP '963 in view of Abe (U.S. Patent no. 5,538,697) set forth on pages 14-15 of appellants' brief. A response is required by the examiner in this regard. MPEP § 1208 (pages 1216-1219), Rev. 1 Aug. 2001.

We also note that there is a discrepancy between which claims are rejected under this rejection. That is, on page 14 of the brief, appellants indicate that claim 16 is also rejected, whereas on page 5 of the answer, claim 16 is not rejected.

We also note that the examiner does not list on page 3 of the answer, U.S. Patent No. 5,538,697, as part of the prior art of record, yet, the examiner relies upon this reference in the rejections.

Because the answer is incomplete, we remand this application to the examiner for action consistent with the above. Furthermore, a Reply Brief was filed February 19, 2002. We authorize the examiner to prepare a supplemental answer responding to the arguments set forth therein.

IV. Conclusion

We remand this application to the jurisdiction of the examiner.

This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01d (8th ed., Aug.

Appeal No. 2002-16
Application No. 08/997,774

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